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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,753	06/01/2001	Gregory Scott Friedman	05146.00005	9903

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Robert D. Becker  
Manatt, Phelps & Phillips, LLP  
1001 Page Mill Road  
Building 2  
Palo Alto, CA 94304

EXAMINER

BAKER, PAUL A

ART UNIT	PAPER NUMBER
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2188

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/872,753	Applicant(s) FRIEDMAN ET AL.	
	Examiner Paul A. Baker	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,8 and 15 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6,14,16,18-22,25-27 and 30 is/are allowed.
- 6) ☒ Claim(s) 9,11,17,24,28,31-33,36 and 37 is/are rejected.
- 7) ☒ Claim(s) 10,12,13,23,29,34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's disclosure does not support a second retrieval operation retrieves a second and first hierarchical level of information.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31, 33 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan et al. "Application of Compaction Technique to Optimizing Wireless Email Transfer"

In regards to claim 31, Chan discloses a method of caching information relating to a set of electronic mail messages comprising:

providing a first memory storing a set of electronic mail messages (inherent to the server); wherein information of each of each mail messages is categorized into hierarchical levels on page 1534 section III lines 6-21;

in a first retrieval operation, retrieving from the first memory and storing into a second memory (inherent to the mobile device) only a first hierarchical level of information corresponding to at least one of the electronic mail messages on page 1534 section III lines 6-10; and

in a second retrieval operation separate from first retrieval operation, retrieving from the first memory and storing into the second memory only a second hierarchical level of information corresponding to the at least one of the electronic mail messages, wherein the second hierarchical level of information comprises text content of the body of the at least one of the electronic mail messages on page 1534 section III lines 11-21.

In regards to claim 33, Chan discloses a method of caching information relating to a set of data items, comprising:

categorizing information of each set of data items into hierarchical levels on page 1534 section III lines 6-21;

in a first retrieval operation, retrieving and storing into a memory (inherent to the mobile device) a first hierarchical level of information corresponding to at least one of the data items on page 1534 section III lines 6-10; and

in a second retrieval operation separate from first retrieval operation, retrieving from and storing into the memory a second hierarchical level of information corresponding to the at least one of the data items on page 1534 section III lines 11-21.

In regards to claim 36, Chan discloses the second retrieval operation retrieves and stores into the memory only the second hierarchical level of information on page 1534 section III lines 11-21.

Claim 32 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ulrich, US Patent 6,052,735. Ulrich discloses a method of caching information relating to a set of electronic mail messages, comprising:

providing a first memory storing a set of electronic mail messages in figure 1 element 8; wherein information of each of the mail messages is categorized into hierarchical levels in column 4 lines 14-27;

in a first retrieval operation retrieving from the first memory and storing into a second memory (figure 1 element 6) only a first hierarchical level of information corresponding to at least one of the electronic mail messages in column 4 lines 40-44; and

in a second retrieval operation separate from first retrieval operation, retrieving from the first memory and storing into the second memory only a second hierarchical level of information corresponding to the at least one of the electronic mail messages,

wherein the second hierarchical level of information comprises an attachment to the at least one of the electronic mail messages in column 4 lines 45-48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11, 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. "Application of Compaction Technique to Optimizing Wireless Email Transfer" in view of Ulrich et al. US Patent 6,052,735.

In regards to claim 9, Chan discloses a method of caching information relating to a set of data items comprising:

in a first retrieval operation, retrieving and storing into a memory only a first hierarchical level of information corresponding to at least one of the data items on page 1534 Section III 3<sup>rd</sup> paragraph lines 9-12:

in a second retrieval operation separate from the first retrieval operation, retrieving and storing into the memory only a second hierarchical level of information corresponding to the at least one of the data items on page 1534 Section III 3<sup>rd</sup> paragraph lines 10-21.

Chan does not disclose in a third retrieval operation separate from the first and second retrieval operations, retrieving and storing into the memory only a third hierarchical level of information corresponding to the at least one of the data items.

Ulrich discloses in column 3 lines 15-21 dynamically retrieving attachments on a per message basis. Chan discloses in column 2 lines 50-59 "that it may be desirable for the user of the mobile device to receive only certain attachments to electronic mail messages, chosen by the user dynamically on an ad hoc basis, or chosen according to preselectable filtering criteria." Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer attachments within Chan as part of the hierarchical retrieval of information.

In regards to claim 11, Ulrich discloses in column 3 lines 15-21 the third level of hierarchical information is an attachment to each of the at least one of the data items.

In regards to claim 17, Ulrich discloses the set of data items are stored in a memory associated with a user's regular electronic mail account, and the first, second and third retrieval operations comprise storing the first, second and third hierarchical levels of information in a memory associated with a user's portable electronic mail account in figure 5 elements 3, 4, 6 and 8.

In regards to claim 24, Chan discloses the data items are electronic mail message data files on page 1534 Section III, 3<sup>rd</sup> paragraph.

In regards to claim 28, Ulrich discloses in column 3 lines 15-21 the data items are electronic mail messages, wherein the second or third level of hierarchical information is an attachment to the at least one electronic mail message.

### ***Allowable Subject Matter***

Claims 10,12,13, 23, 29, 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25-27, 30 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claims 25-27 are allowed as being dependent upon an allowed claim. Claim 30 is allowed for the same reason as set forth in the allowance of claim 14.

### ***Response to Arguments***

Applicant's arguments filed 3 February 2006 have been fully considered but they are not persuasive. Applicant argues that Chan does not disclose two hierarchical levels of information. The examiner would like to illustrate again that Chan discloses sending a concise description of an email to the client (sender name, date, message length and



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subject), this is identical to applicant's claimed *metadata* level of hierarchical information as shown in paragraph 26. Chan further discloses "The client selectively retrieves emails by sending the name of the requested email and the set of reference messages to the server". A client cannot *selectively retrieve* emails without being in possession of the information contained within the first hierarchical level of information. These three sentences in themselves prove Chan's discloses two levels of hierarchical information.

Applicant insinuates that a redundant copy of the header is sent in the second transfer by pointing out the first paragraph of page 1537, however this is not persuasive because the mentioned paragraph is referring to a client-to-server transfer and not a server-to-client transfer. These are two entirely different situations, a person composing an email message on a mobile device would have no desire to send an email to later be followed by a message body, separating the header from the body in a client-to-server transfer provides no functional value to the system since it is known *a priori* that a message body must be sent in order to complete the email transfer and send the message to it's intended recipient. On the rare occasion that the email is "subject only", no message body exists and would automatically be compacted down to a zero length.

The examiner would like to point out there is no extrinsic support for this interpretation of Chan (that a redundant copy of the header is sent), and that such an interpretation would teach away from Chan's stated goal of reducing network bandwidth when such information is already in the possession of the user.

Assuming *arguendo*, that such a redundant transfer of information were to occur, contained within the encoded object sent to the client is additional information (message

body) which constitutes a second hierarchical level of information. The context of the word "separate" used within applicant's claim 9 is in reference to time, in other words, the retrieval of the first and second hierarchical levels of information are separated by a period of time. Applicant's use of open phrasing in describing the content of the hierarchical levels of information within the specification does not support the interpretation of "separate" to mean "exclusive content" within the hierarchical level of information.

The examiner disagrees with the applicant's argument that there is not motivation to combine the aspect of Ulrich relied upon in the rejection of claim 9 with Chan. Ulrich states in column 2 lines 5-18 and lines 50-59 the desirability to be able to transfer attachments of an email to a personal mobile device. Chan's invention at it heart is the use of compaction and the downloading of only that information which is desirable to the client. Given Ulrich's stated desire to enable the downloading of email attachments to a personal mobile device and "that it may be desirable for the user of the mobile device to receive only certain attachments to electronic mail messages, chosen by the user dynamically on an ad hoc basis, or chosen according to preselectable filtering criteria." and that information pertaining to email attachments is not present within header information and therefore would not be selectable until a second hierarchical level of information is available to the user, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a third hierarchical level comprising of an email attachment.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Baker whose telephone number is (571)272-4203. The examiner can normally be reached on M-F 10am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571)272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PB  
PB

Mano Padmanabhan  
6/27/06

MANO PADMANABHAN  
SUPERVISORY PATENT EXAMINER